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In re Application of
ROMAN *et al*
U.S. Application No.: 10/563,025
PCT No.: PCT/EP2004/007195
Int. Filing Date: 30 June 2004
Priority Date: 30 June 2003
Attorney Docket No.: 4258-119
For: IN VITRO METHODS FOR
DETECTING RENAL CANCER

DECISION

This is a decision on the papers filed 03 August 2007 which are treated under 37 CFR 1.497(d).

BACKGROUND

On 02 August 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee were required. Applicants were given two months to respond with extensions of time available.

On 14 September 2006, applicants filed a declaration executed by ten joint inventors along with the \$65.00 surcharge fee.

On 03 July 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) noting that the declaration filed 14 September 2007 was not in compliance with 37 CFR 1.497(a) and (b) because the international publication for PCT/EP2004/007195 lists eleven inventors for the subject application.

On 03 August 2007, applicants filed a response to the Form PCT/DO/EO/916 which was accompanied by, *inter alia*, a letter from a Spanish law firm dated 10 March 2006.

On 11 October 2007, a filing receipt listing ten inventors for the subject application was mailed by the Office.

On 12 October 2007, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating

that the application completed all 35 U.S.C. 371 requirements on 03 August 2007.

DISCUSSION

Applicants claim that Maria Eladia Arguelles Sanchez should be removed as an inventor in the above-captioned application. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). The response filed 03 August 2007 is treated as a petition under 37 CFR 1.497(d).

37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

The processing fee of \$130.00 has been charged to Deposit Account No. 08-3284 as authorized. Item (2) is complete.

Regarding item (1), applicants claim that Ms. Sanchez was named as an inventor by mistake and that diligent efforts have been initiated and are continuing to obtain a statement. Instead, applicants submitted a copy of a letter from a Spanish law firm indicating that the inclusion of Ms. Sanchez as an inventor in the international application was a mistake.

This response is inappropriate.

Section 201.03 of the MPEP discusses situations where the statement from the inventor to be removed cannot be obtained and is applicable to petitions under 37 CFR 1.497(d). It states in the relevant section:

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party

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would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more than one assignee giving its consent, the extent of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor.

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications.

To satisfy this item, applicants must either locate and obtain the consent of Ms. Sanchez, file a petition under 37 CFR 1.183 to waive the requirement, or refile the application as a continuation of PCT/EP2004/007195 naming the correct inventive entity. The letter by the Spanish law firm does not meet this requirement. Item (1) of 37 CFR 1.497(d) is not satisfied.

Concerning item (3), applicants have not provided written consent of the assignee, or made a claim that no written assignment exists. Applicants must address this requirement. For this reason, item (3) of 37 CFR 1.497(d) is also not satisfied.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

The filing receipt mailed 11 October 2007 and the Form PCT/DO/EO/903 mailed 12 October 2007 were sent in error, and are hereby **VACATED**.

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Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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